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OFFICE OF PETITIONS

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|-----------------------------------|---|----------------------------|
| In re Application of | : | |
| Kladders et al. | : | |
| Application No. 10/757047 | : | DECISION ON APPLICATION |
| Filing or 371(c) Date: 01/14/2004 | : | FOR PATENT TERM ADJUSTMENT |
| Attorney Docket Number: | : | |
| 01-1449 | : | |

This is a decision on the "APPLICATION FOR PATENT TERM ADJUSTMENT," filed October 1, 2010. Applicants submit that the correct patent term adjustment is 1278 days, not 1227 days as calculated by the Office as of the mailing of the initial determination of patent term adjustment. The basis for Applicants' request is (1) an assertion that the Office erred in calculating an adjustment of 1068 days pursuant to 37 CFR 1.702(a)(1); (2) an assertion that the Office erred in failing to calculate a reduction of 11 days pursuant to 37 CFR 1.704(b), and (3) the Office will take in excess of three years to issue this patent. The Application for Patent Term Adjustment is properly treated under 37 C.F.R. § 1.705(b).

The Application for Patent Term Adjustment under 37 CFR 1.705(b), as it relates to the assertion that the Office erred in calculating an adjustment of 1068 days pursuant to 37 CFR 1.702(a)(1), and an assertion that the Office erred in failing to calculate a reduction of 11 days pursuant to 37 CFR 1.704(b), is **GRANTED**.

The Application for Patent Term under 37 CFR 1.705(b), as it relates to the Office's failure to issue the patent within 3 years of the filing date, the application for patent term adjustment under 37 CFR 1.705(b) is **DISMISSED as PREMATURE**.

BACKGROUND

The application was filed on January 14, 2004. On July 1, 2010, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment (PTA) to date is 1227 days.

On October 1, 2010, applicants timely submitted the present request for reconsideration of patent term adjustment¹. Applicants assert that the Office erred in calculating an adjustment of 1068 days pursuant to 37 CFR 1.702(a)(1), in connection with the mailing of a non-final Office action on April 17, 2007. Applicants provide that the application was filed under 35 U.S.C. § 111(a), and the day after the date that is 14 months after the date on which the application was filed is March 15, 2005. The first Office action under 35 U.S.C. 132 was mailed on April 17, 2007, which is 764 days after the date that is 14 months after the date on which the application was filed. As such, Applicants provide that the adjustment pursuant to 37 CFR §§ 1.702(a)(1) and 1.703(a)(1) is 764 days.

Applicants also aver that the Office erred in failing to calculate an adjustment 11 days in connection with the filing of a response to a final Office action mailed October 4, 2007, to which a response was not filed until January 15, 2008, three months and 11 days after the mail date of the final Office action. Pursuant to 37 CFR 1.704(b), Applicants provide that an 11 day reduction is appropriate.

Applicants do not dispute an adjustment of 165 days pursuant to 37 CFR 1.702(a)(4), or a reduction of 6 days pursuant to 37 CFR 1.704(b).

OPINION

Applicants' arguments have been carefully considered. A review of Office records confirm that a first Office action under 35 U.S.C. 132 was mailed on April 17, 2007, 14 months and 764 days after the date on which the application was filed under 35 U.S.C. § 111(a). The Office agrees that the adjustment pursuant to 37 CFR §§ 1.702(a)(1) and 1.703(a)(1) is 764 days.

Office records also confirm that a final Office action was mailed October 4, 2007, to which a response was filed on January 15, 2008, three months and 11 days after the mail date of the final Office action. Pursuant to 37 CFR 1.704(b), a reduction of 11 days is appropriate.

In view thereof, the correct Patent Term Adjustment at the time of the mailing of the Notice of Allowance is nine hundred twelve (912) days, subject to any terminal disclaimer.

With regard to the argument under 37 CFR 1.702(b), knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term patentee is entitled to for Office failure to issue the patent within 3 years. See § 1.702(b). (This is true even where a request for continued examination (RCE) was filed). The computer will not undertake the § 1.702(b) calculation until the actual date of issuance of the patent has been determined. Likewise, the computer will not calculate any further Office delay under § 1.702(a)(4) or applicant delay under § 1.704(c)(10) until the actual date of issuance of the patent has been determined. As such, the Office can not make a determination on the correctness of the patent term adjustment until the patent has issued.

Requesting reconsideration of the patent term adjustment to be indicated on the patent under 37 CFR 1.705(b) based on the initial determination of patent term adjustment and a projected

¹ Office records show that the Issue Fee payment was received in the Office on October 1, 2010.

issuance date of the patent (or even the filing date of the request for continued examination) is premature. Accordingly, it is appropriate to dismiss as premature such a request.

Rather than file an application for patent term adjustment under 37 CFR 1.705(b) contesting the 37 CFR 1.702(b) calculation at the time of the mailing of the notice of allowance, applicant is advised that they may wait until the time of the issuance of the patent and file a request for reconsideration of the patent term adjustment pursuant to 37 CFR 1.705(d). As the USPTO does not calculate the amount of time earned pursuant to 37 CFR 1.702(b) until the time of the issuance of the patent, the Office will consider any request for reconsideration of the patent term adjustment due to an error in the calculation of 37 CFR 1.702(b) to be timely if the request for reconsideration is filed within two months of the issuance of the patent. However, as to all other bases for contesting the initial determination of patent term adjustment received with the notice of allowance, applicant must timely file an application for patent term adjustment prior to the payment of the issue fee².

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e) for consideration of the application for patent term adjustment under 37 CFR 1.705(b).

Any request for reconsideration of the patent term adjustment indicated on the patent must be timely filed within 2 months after issuance pursuant to 37 CFR 1.705(d) and **must** include payment of the required fee under 37 CFR 1.18(e).

The Office of Data Management has been advised of this decision. This application is being referred to the Office of Data Management for issuance of the patent.

Telephone inquiries specific to this matter should be directed to Attorney Derek Woods at (571) 272-3232.



Anthony Knight
Director
Office of Petitions

² For example, if applicant disputes both the calculation of patent term adjustment under 37 CFR 1.702(a)(1) for Office failure to mail a first Office action or notice of allowance not later than fourteen months after the date on which the application was filed and under 37 CFR 1.702(b) for Office failure to issue a patent within three years of the actual filing date of the application, then applicant must still timely file an application for patent term adjustment prior to the payment of the issue fee to contest the calculation of Office delay in issuing a first Office action or notice of allowance. See 37 CFR 1.705(b) and 35 U.S.C. 154(b)(3)(B). A dispute as to the calculation of the §1.702(a)(1) period raised on request for reconsideration of patent term adjustment under 37 CFR 1.705(d) will be dismissed as untimely filed.



Patent Term Adjustments



PTA/PTE Information Patent Term Adjustment Patent Term Extension

Application Number*: 10757047 Search Explanation of PTA Calculation Explanation of PTE Calculation

PTA Calculations for Application: 10757047

| | |
|------------------------------------|---|
| Application Filing Date 01/14/2004 | Overlapping Days Between (A and B) or (A and C) 0 |
| Issue Date of Patent | Non-Overlapping USPTO Delays: 1233 |
| A Delays: 1233 | PTO Manual Adjustment: 315 |
| B Delays: 0 | Applicant Delay (APPL): 6 |
| C Delays: 0 | Total PTA (days): 912 |

* - Sorted Column

File Contents History

| Action Number | Action Recorded Date | Action Due Date | Action Code | Action Description | Duration PTO | Duration APPL | Parent Action Number |
|---------------|----------------------|-----------------|-------------|---|--------------|---------------|----------------------|
| 106 | 12/12/2010 | | P028 | Adjustment of PTA Calculation by PTO | | | |
| 96 | 07/01/2010 | | NN/- | Mail Notice of Allowance | | | 0 |
| 95 | 06/29/2010 | | N/- | Notice of Allowance Data Verification Completed | | | 0 |
| 94 | 06/24/2010 | | IREV | Issue Revision Completed | | | 0 |
| 93 | 06/24/2010 | | DVER | Document Verification | | | 0 |
| 92 | 06/24/2010 | | EKA | Examiner's Amendment Communication | | | 0 |
| 91 | 06/24/2010 | | CNTA | Notice of Allowability | | | 0 |
| 89 | 05/25/2010 | | FWDX | Date Forwarded to Examiner | | | 0 |
| 90 | 05/18/2010 | | C614 | New or Additional Drawing Filed | | | 0 |
| 88 | 05/18/2010 | | NCTNF | Response after Non-Final Action | | | 0 |
| 87 | 05/17/2010 | | EML_NTF | Email Notification | | | 0 |
| 86 | 05/17/2010 | | MEKIN | Mail Examiner Interview Summary (PTOL - 413) | | | 0 |
| 85 | 05/17/2010 | | EXIN | Examiner Interview Summary Record (PTOL - 413) | | | 0 |
| 84 | 02/18/2010 | | ELC_RVW | Electronic Review | | | 0 |
| 83 | 02/18/2010 | | ERL_NTF | Email Notification | | | 0 |
| 82 | 02/18/2010 | | MCTNF | Mail Non-Final Rejection | | | 0 |
| 81 | 02/08/2010 | | CTNF | Non-Final Rejection | | | 0 |
| 80 | 02/04/2010 | | FWDX | Date Forwarded to Examiner | | | 0 |
| 77 | 02/04/2010 | | ABN9 | Disposal for a RCE / CPA / R129 | | | 0 |
| 79 | 02/02/2010 | | AMSB | Amendment Submitted/Entered with Filing of CPA/RCE | | | 0 |
| 78 | 02/02/2010 | 01/27/2010 | RCEX | Request for Continued Examination (RCE) | | | 72 |
| 76 | 02/02/2010 | | XT/G | Request for Extension of Time - Granted | | | 0 |
| 75 | 02/02/2010 | | BRCE | Workflow - Request for RCE - Begin | | | 0 |
| 74 | 10/27/2009 | | ELC_RVW | Electronic Review | | | 0 |
| 73 | 10/27/2009 | | EML_NTF | Email Notification | | | 0 |
| 72 | 10/27/2009 | | MCTFR | Mail Final Rejection (PTOL - 326) | | | 0 |
| 71 | 10/23/2009 | | CTFR | Final Rejection | | | 0 |
| 70 | 09/09/2009 | | FWDX | Date Forwarded to Examiner | | | 0 |
| 69 | 07/27/2009 | | NCTNF | Response after Non-Final Action | | | 0 |
| 68 | 05/07/2009 | | CTNF | Non-Final Rejection | | | 0 |
| 67 | 05/07/2009 | | CTNF | Non-Final Rejection | | | 0 |
| 65 | 03/13/2009 | | FIDC | Finished Initial Data Capture | | | 0 |
| 64 | 02/27/2009 | | LET | Miscellaneous Incoming Letter | | | 0 |
| 63 | 02/26/2009 | | FWDX | Date Forwarded to Examiner | | | 0 |
| 62 | 02/06/2009 | | EIDC | Export to Initial Data Capture | | | 0 |
| 61 | 02/02/2009 | | HEXA | Mail Examiner's Amendment | | | 0 |
| 60 | 02/02/2009 | 08/21/2008 | NN/- | Mail Notice of Allowance | | 165 | 45 |
| 59 | 01/30/2009 | | IREV | Issue Revision Completed | | | 0 |
| 58 | 01/30/2009 | | DVER | Document Verification | | | 0 |
| 57 | 01/30/2009 | | N/- | Notice of Allowance Data Verification Completed | | | 0 |
| 56 | 01/30/2009 | | DOCK | Case Docketed to Examiner in GAU | | | 0 |
| 55 | 01/28/2009 | | EKA | Examiner's Amendment Communication | | | 0 |
| 54 | 01/28/2009 | | CNTA | Notice of Allowability | | | 0 |
| 53 | 01/28/2009 | | MEKIN | Mail Examiner Interview Summary (PTOL - 413) | | | 0 |
| 48 | 01/22/2009 | | EXIN | Examiner Interview Summary Record (PTOL - 413) | | | 0 |
| 47 | 10/10/2008 | | DOCK | Case Docketed to Examiner in GAU | | | 0 |
| 46 | 05/14/2008 | | FWDX | Date Forwarded to Examiner | | | 0 |
| 45 | 04/21/2008 | | NCTNF | Response after Non-Final Action | | | 0 |
| 44 | 03/12/2008 | | MCTNF | Mail Non-Final Rejection | | | 0 |
| 43 | 02/19/2008 | | CTNF | Non-Final Rejection | | | 0 |
| 42 | 01/15/2008 | | FWDX | Date Forwarded to Examiner | | | 0 |
| 41 | 01/15/2008 | | AMSB | Amendment Submitted/Entered with Filing of CPA/RCE | | | 0 |
| 40 | 01/15/2008 | | FWDX | Date Forwarded to Examiner | | | 0 |
| 38 | 01/15/2008 | | ABN9 | Disposal for a RCE / CPA / R129 | | | 0 |
| 36 | 01/15/2008 | | BRCE | Workflow - Request for RCE - Begin | | | 0 |
| 35 | 12/11/2007 | | MCTAV | Mail Advisory Action (PTOL - 303) | | | 0 |
| 34 | 12/10/2007 | | CTAV | Advisory Action (PTOL - 303) | | | 0 |
| 32 | 11/08/2007 | | FWDX | Date Forwarded to Examiner | | | 0 |
| 33 | 11/06/2007 | | C614 | New or Additional Drawing Filed | | | 0 |
| 31 | 11/06/2007 | | ALNE | Amendment after Final Rejection | | | 0 |
| 30 | 10/04/2007 | | MCTFR | Mail Final Rejection (PTOL - 326) | | | 0 |
| 29 | 10/01/2007 | | CTFR | Final Rejection | | | 0 |
| 28 | 07/19/2007 | | FWDX | Date Forwarded to Examiner | | | 0 |
| 27 | 07/16/2007 | | NCTNF | Response after Non-Final Action | | | 0 |
| 26 | 04/17/2007 | 05/14/2004 | MCTNF | Mail Non-Final Rejection | | 1058 | 1 |
| 25 | 04/03/2007 | | CTNF | Non-Final Rejection | | | 0 |
| 39 | 03/15/2007 | | RCEX | Request for Continued Examination (RCE) | | | 0 |
| 37 | 03/15/2007 | | XT/G | Request for Extension of Time - Granted | | | 0 |
| 21 | 10/12/2006 | | DOCK | Case Docketed to Examiner in GAU | | | 0 |
| 20 | 04/19/2006 | | DOCK | Case Docketed to Examiner in GAU | | | 0 |
| 19 | 02/15/2006 | | DOCK | Case Docketed to Examiner in GAU | | | 0 |
| 18 | 12/08/2004 | | DOCK | Case Docketed to Examiner in GAU | | | 0 |
| 22 | 11/17/2004 | | IDSC | Information Disclosure Statement considered | | | 0 |
| 18 | 11/17/2004 | | RCAP | Reference capture on IDS | | | 0 |
| 17.7 | 11/17/2004 | | MB44 | Information Disclosure Statement (IDS) Filed | | | 0 |
| 17 | 11/17/2004 | | WIDS | Information Disclosure Statement (IDS) Filed | | | 0 |
| 14 | 10/02/2004 | | TSSCOMP | IFW TSS Processing by Tech Center Complete | | | 0 |
| 11 | 05/12/2004 | | WDOIPE | Application Return from OIPE | | | 0 |
| 10 | 05/12/2004 | | ROIPE | Application Return TO OIPE | | | 0 |
| 8 | 05/12/2004 | | COMP | Application Is Now Complete | | | 0 |
| 9 | 05/11/2004 | | OIPE | Application Dispatched from OIPE | | | 0 |
| 24 | 04/22/2004 | | IDSC | Information Disclosure Statement considered | | | 0 |
| 13 | 04/22/2004 | | RCAP | Reference capture on IDS | | | 0 |
| 12.7 | 04/22/2004 | | MB44 | Information Disclosure Statement (IDS) Filed | | | 0 |
| 12 | 04/22/2004 | | WIDS | Information Disclosure Statement (IDS) Filed | | | 0 |
| 7 | 04/20/2004 | | ADDFEE | Additional Application Filing Fees | | | 0 |
| 6 | 04/20/2004 | | DATADECL | A statement by one or more inventors satisfying the requirement under 35 USC 115, Oath of the Applicant | | | 0 |
| 5 | 04/16/2004 | | INCD | Notice Mailed--Application Incomplete--Filing Date Assigned | | | 0 |
| 4 | 03/04/2004 | | L194 | Cleared by OIPE CSR | | | 0 |
| 3 | 03/04/2004 | | CLES | CASE CLASSIFIED BY OIPE | | | 0 |
| 2 | 01/31/2004 | | SCAN | IFW Scan & PACR Auto Security Review | | | 0 |
| 23 | 01/14/2004 | | IDSC | Information Disclosure Statement considered | | | 0 |
| 16.7 | 01/14/2004 | | MB44 | Information Disclosure Statement (IDS) Filed | | | 0 |
| 16 | 01/14/2004 | | WIDS | Information Disclosure Statement (IDS) Filed | | | 0 |
| 1 | 01/14/2004 | | IECX | Initial Exam Team nn | | | 0 |

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